

REMARKS

Claim amendments:

Claim 1 has been amended to correct punctuation errors. Claims 15-17 have been amended to recite language for which there is clearly antecedent basis. These amendments do not expand or narrow the scope of the claims. Applicants further submit claims 1 and 15-17 satisfied the requirements under 35 U.S.C. §112, first and second paragraphs prior to these amendments. One skilled in the art would recognize what subject matter was defined by claims 15-17 even if antecedent basis for the language “the content of Rutin,” is absent as alleged. The above amendments have been made to eliminate these issues and expedite the prosecution of the application. The amendments are not necessary to render the claims patentable when interpreted in light of the specification.

Double Patenting:

Applicants maintain claims 1 and 23-27 herein do not claim the same subject matter as claims 18 and 21-23 of U.S. Patent 6,649,150. Claim 18 of the '150 patent and the claims which depend thereon define a "powder" consisting essentially of 40% by weight of Emblicanin A, Emblicanin B, Pedunculagin and Punigluconin and less than about 1% by weight of flavonoids.

In contrast, claims 1 and 23-27 herein define an "extract" of Emblicanin officinalis with these components. These claims encompass formulations which contain these components as a powder in addition to a physical form other than a powder.

On page 5, lines 26-34, of the specification it is stated that, "In general, the standardized extract is sold as a powder in packaged form..." This disclosure teaches that the extract is not limited to this 'powder in packaged form.'

Page 6, lines 1-3, of the specification teach that the “standardized extract powdery material,” can be “incorporated in a cosmetically or pharmaceutically acceptable carrier.” The extract in this form is not a powder but a suspended solid. On page 4, lines 10-13, of the specification, reference is made to the publication entitled, “Ingredients/Emblica, Bearing Fruit (SIC), by Ratan K. Chaudhuri. The contents of this publication are incorporated into the specification by reference. (See page 19, lines 28-29 of the specification). On page 30 of this publication under the heading "Formulation guide" the use of "emblica cascading antioxidant,” an extract from premium quality fruits, is said to be used as a "suspension."

Claims 18 and 21-23 of U.S. Patent 6,649,150 define only powders, not suspensions. Therefore, claims 1 and 23-27 herein are not coextensive with any of the claims in U.S. Patent 6,649,150 and the double-patenting rejection under 35 U.S.C. §101 should be withdrawn.

Claims 23-26

The extract in each of claims 23-26 have a maximum absorbance (optical density) prescribed for only one wave-length whereas the powders of claims 21-23 of U.S. Patent 6,649,150 have the maximum absorbance prescribed for 5 wavelengths. Therefore, claims 23-26 herein are clearly not coextensive of any claims in U.S. Patent 6,649,150 and there is no basis for the double-patenting rejection of these claims under 35 U.S.C. §101.

Obviousness type Double Patenting:

Claims 1-3, 10 and 11 herein in view of claims 16, 18 and 19 of Co-pending application no. 10/571,588

The provisional obviousness type double patenting rejection based on claims 16, 18 and 19 of co-pending application no. 10/571,588 is without basis in that the compositions therein are defined by completely different parameters than the compositions of claims 1-3, 10 and 11 herein; and are unobvious. The powders of claim 16 of the '588 application comprise at least 70 wt% low molecular weight tannins which is not prescribed by the 4 components found in the extracts and compositions of claims 1-3, 10 and 11 herein. There is no direction or other basis for one skilled in the art to find the subject of the claims within either application to be obvious in view of the subject matter defined in the claims of the other.

The powders of claim 18 of the '588 application (and the compositions which they form/claim 19) are also patentably distinct from the powders of claims 1-3, 10 and 11 herein in that they are substantially to completely devoid of black specs, which is not an obvious feature. In addition, there is no mention of the 4 components required of the extracts claimed herein in claims 18 and 19 of the 588 application.

Furthermore, as the earlier filed application, should this "provisional" non-statutory obviousness-type double patenting rejection be the only remaining rejection, MPEP 804 (I)(B) provides this rejection should be withdrawn without filing a terminal disclaimer to allow this application to issue.

In view of the remarks above, applicants submit the provisional obviousness type double patenting rejection based on co-pending application no. 10/571588 should be withdrawn.

Claims 1-7, 10-13 and 15-27 herein in view of claims 1-17, 19 and 20 of U.S. Patent 6,649,150

Applicants also traverse the rejection for obviousness type double patenting of claims 1-7, 10-13 and 15-27 based on claims 1-17, 19 and 20 of U.S. Patent 6,649,150. As discussed above, the subject matter of the claims in U.S. Patent No. 6,649,150 is directed to powders whereas the claims herein are not restricted to such a physical state. There is no evidence one skilled in the art would find it obvious to expand the physical forms for the components defined in the claims within U.S. Patent No. 6,649,150. Therefore the rejection based on obviousness type double-patenting should be withdrawn.

Claims 11 and 14 herein in view of claim 1 of U.S. Patent 6,969,509

There is no basis for the provisional obviousness type double patenting rejection of composition claim 11 herein based on the methods of lightening and whitening or even-toning skin color of claim 1 of US Patent 6,969,509. The methods of the '509 patent were found to be patentably distinct from the powder compositions claimed in US Patent 6,649,150 and were required to be restricted from the application which issued as US Patent no. 6,649,150 patent. The compositions of claim 11, which contain "extracts," are clearly further distinguished from the methods of claim 1 of the '509 patent.

The methods of claim 14 herein are also patentably distinct from those of the methods of claim 1 of U.S. Patent No. 6,969,509 in that the methods claimed herein are not restricted to the use of a powder. There is no hint or suggestion the extract can be used in other forms based on claim 1 of the U.S. Patent No. 6,969,509. Furthermore, the methods of claim 14 herein prescribe the use of a "composition" having 90-99.7% by weight of the extract. The methods of claim 1 of U.S. Patent 6,969,509 provide no hint or suggestion to select the use of such a concentrated composition. As such, the subject matter of these claims is patentably distinct from that of claim 1 of the '509 patent.

In view of the above remarks, favorable reconsideration is courteously requested. If there are any remaining issues which could be expedited by a telephone conference, the Examiner is courteously invited to telephone counsel at the number indicated below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

/Richard J. Traverso/

Richard J. Traverso, Reg. No. 30,595
Attorney for Applicant(s)

MILLEN, WHITE, ZELANO
& BRANIGAN, P.C.
2200 Clarendon Boulevard, Suite 1400
Arlington, Virginia 22201
Telephone: (703) 243-6333, Facsimile: (703) 243-6410

Attorney Docket No.: MERCK-2896

Date: December 10, 2008